

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MAKOTO TOMIOKA

Appeal No. 96-1480
Application No. 08/179,779¹

ON BRIEF

Before HAIRSTON, JERRY SMITH and KRASS, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 6 through 28. In the parent application, the Board in a

¹ Application for patent filed January 10, 1994. According to the appellant, the application is a continuation of Application No. 07/770,713, filed October 3, 1991, now abandoned, which is a continuation of Application No. 07/362,402, filed July 5, 1989, now abandoned.

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decision (93-1876) dated November 11, 1993, sustained the obviousness rejection of claims 6 through 22.

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Claim 6 on appeal is as follows:

6. A data code support, such as a card or sheet comprising a surface having at least one predetermined unit of surface area delineated thereon, said at least one predetermined unit of surface area being divided into four regions having similar dimensions, each region of said four regions constituting a unitary recording area and portraying a different binary notation commencing with the lowest order of binary notations and thereafter successive binary notations, said lowest order of binary notations being depicted by a unitary recorded area or region being shaded to represent the lowest order of a binary notation value of a group of selected binary notation values, the remainder of said regions selectively being shaded to depict any one of a predetermined number of selected binary notation values.

Claim 6 in the parent application is reproduced as follows:

6. A data code support, such as a card or sheet comprising a surface having at least one unit of surface area delineated thereon, said at least one unit of surface area being divided into at least two regions having similar dimensions, each region of said at least two regions portraying a different column of binary notation commencing with the lowest order column of binary notation and thereafter the successive columns of binary notation, identical regions of said at least one unit representing the same column, at least one region of said at least one unit being shaded to represent one binary notation value of a group of selected binary notation values, each binary notation value of said group of selected binary notation values having a predetermined number and complementary arrangement of said shaded regions.

Claim 23 was added in this application, and it reads as follows:

23. A data code recognition method, said method comprising the steps of:

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defining a data code support having a surface with at least one predetermined unit of surface area delineated thereon, said at least one predetermined unit of surface area being divided into four equal regions having similar dimensions, each region of said four regions constituting a unitary recording area and portraying a different binary notation commencing with the lowest order of binary notation and thereafter successive binary notations, said lowest order of binary notations being depicted by a unitary recording area or region being shaded to represent the lowest order of a binary notation value of a group of selected binary notation values, the remainder of said regions selectively being shaded to depict any one of a predetermined number of selected notation values;

placing an apparatus for reading a data code on said defined data code support adjacent said defined data code support;

directing light signals onto said data code support from a light source of said apparatus for reading the data code of said data code support;

receiving the reflected or transmitted light signals from said light source directed onto said data code support by said apparatus for reading the data code;

simultaneous with said receiving step, corresponding said light signals received by said apparatus for each shaded region being read by said apparatus as 1, and for each region being not so shaded as 0, such that said data code on said data code support is read directly into digital signals.

In response to the examiner's statement (final rejection, page 2) that "Claims 6-28 are rejected as set forth previously," appellant states (Brief, page 2) that "it is not clear how new Claims 23 through 28 are rejected 'as set forth

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previously' since no specific rejection relative to these claims has ever been made of record by the Examiner with respect to any prior art 'as set forth previously'." In a summation of the status of the claims, appellant also states (Brief, page 3) that "[t]he very general rejection set forth with respect to Claims 6 through 28 both in the Office Action of July 1, 1994, and February 1, 1995, does not meet the burden the CAFC has placed upon the Patent Office in order to state a 35 U.S.C. 103 rejection."

In view of the amendments made to claims 6 through 22, and the newly added claims 23 through 28, we must agree with appellant that the examiner has not established a prima facie case of obviousness. As indicated supra, the claims on appeal are not the claims that were presented in the parent application. It follows, therefore, that the claims on appeal can not be rejected "as set forth previously" (final rejection, page 2) because the claims on appeal are not "the same as previously adjudicated by the Appellant Forum [sic, Board] in paper no. 22" (Answer, page 2). If the claims on appeal are rejected "as set forth previously," then does the

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appeal also include the two rejections² that the Board reversed in the prior appeal?

In addition to the lack of a positive statement of the rejection(s), the Examiner's Answer lacks a response to appellant's extensive analysis of the claimed invention and the applied prior art under Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966) (Brief, pages 8 through 20).

In summary, a prima facie case of unpatentability of the claimed invention has not been established by the examiner. The examiner's rejection(s), if any, of the claimed invention are reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
ERROL A. KRASS)	APPEALS
Administrative Patent Judge)	AND

² The rejections of claims 6 through 22 under the second paragraph of 35 U.S.C. § 112, and 35 U.S.C. § 102(b) were reversed.

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)	INTERFERENCES
)	
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)	
JERRY SMITH)	
Administrative Patent Judge)	

jrg

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Mr. Remy J. VanOphem
REMY J. VANOPHEM, P.C.
755 W. Big Beaver
Suite 1313
Troy, Michigan 48084-4903

JENINE GILLIS

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Serial No. 08/179,779

Judge HAIRSTON

Judge JERRY SMITH

Judge KRASS

Received: 03/09/99

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DECISION: REVERSED

Send Reference(s): Yes No
or Translation(s)

Panel Change: Yes No

3-Person Conf. Yes No

Remanded: Yes No

Brief or Heard

Group Art Unit: 2514

Index Sheet-2901 Rejection(s): _____

Acts 2: _____

Palm: _____

Mailed: Updated Monthly Disk (FOIA): _____

Updated Monthly Report: _____

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